



21 SEP 2006

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In re Application of :  
Grech et al. :  
Application No.: 10/540,006 :  
PCT No.: PCT/US03/38021 :  
Int. Filing Date: 26 November 2003 : DECISION  
Priority Date: 30 November 2002 :  
Attorney Docket No.: 4623C-083/NPB :  
For: Reduced Water Consumption Flush Toilet :

This is in response to the correspondence filed on 21 July 2006, which is being treated under 37 CFR 1.497(d).

### **BACKGROUND**

This international application was filed on 26 November 2003 and claimed a priority date of 30 November 2002. The United States was designated. Consequently, the thirty month period for payment of the basic national fee in the United States expired as of midnight on 30 May 2005. This international application became abandoned with respect to the national stage in the United States for failure to timely pay the basic national fee.

On 20 June 2005, applicants filed a petition under 37 CFR 1.137(b).

On 25 January 2006, a decision granting the petition filed on 20 June 2005 was mailed.

On 01 February 2006, a Notification of Missing Requirements (Form PCT/DO/EO/905) was mailed to applicants, requiring the submission of an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b) and a surcharge under 37 CFR 1.492(h).

On 01 May 2006, applicants filed a response, including the surcharge under 37 CFR 1.492(h), with a petition and fee for a one-month extension of time.

On 21 June 2006, a Notification of Defective Response (Form PCT/DO/EO/916) was mailed to applicants, again requiring the submission of an oath or declaration of the inventors in compliance with 37 CFR 1.497(a) and (b), and noting that "all the inventors mentioned on the published international application didn't sign the declaration and the assignment. In addition, I do not have an IB Form 306 indicating any changes."

### **DISCUSSION**

The declarations of the inventors filed on 21 July 2006 reveals that one of the documents lists a joint inventor, Brian Kelly, who was not nominated in the published international application, and does not list Kim Keith and Greg Exner, who were nominated in the published international application. Counsel requests correction of inventorship under 37 CFR 1.48, but the regulation applicable to the instant situation is 37 CFR 1.497(d). A declaration filed under 37 CFR 1.497 (d) must be by the actual inventor or inventors as required under 37 CFR 1.63 or as

permitted by 37 CFR 1.42, 1.43 or 1.47. The declaration must be accompanied by (1) a statement from each person being added as an inventor and from each person being deleted as an inventor that the error in inventorship occurred without deceptive intention on his or her part, (2) the processing fee set forth in 37 CFR 1.17; and (3) if an assignment has been executed by any of the original named inventors, the written consent of the assignee (*See* 37 CFR 3.73(b)). *See* Section 201.03 of the Manual of Patent Examining Procedure (M.P.E.P.).

Regarding requirement (1), applicants have provided appropriate statements by Kim Keith and Greg Exner, but no statement by Brian Kelly has been furnished. Accordingly, requirement (1) has not been satisfied.

Regarding requirement (2), the required processing fee was paid on 21 July 2006.

Regarding requirement (3), the "Written Consent By Assignee Under 37 CFR §1.48(a)(5)" document included among the instant correspondence is signed on behalf of THETFORD CORPORATION by Greg Exner in his capacity as "Vice President of Global Engineering." Counsel's attention is drawn to 37 CFR 3.73(b), which provides that

(1) In order to request or take action in a patent or trademark matter, the assignee must establish its ownership of the patent or trademark property of paragraph (a) of this section to the satisfaction of the Director. The establishment of ownership by the assignee may be combined with the paper that requests or takes the action. Ownership is established by submitting to the Office a signed statement identifying the assignee, accompanied by either:

(i) Documentary evidence of a chain of title from the original owner to the assignee (e.g., copy of an executed assignment). The documents submitted to establish ownership may be required to be recorded pursuant to § 3.11 in the assignment records of the Office as a condition to permitting the assignee to take action in a matter pending before the Office; or

(ii) A statement specifying where documentary evidence of a chain of title from the original owner to the assignee is recorded in the assignment records of the Office (e.g., reel and frame number).

(2) The submission establishing ownership must show that the person signing the submission is a person authorized to act on behalf of the assignee by:

(i) Including a statement that the person signing the submission is authorized to act on behalf of the assignee; or

(ii) Being signed by a person having apparent authority to sign on behalf of the assignee, e.g., an officer of the assignee.

The instant "Written Consent By Assignee..." does not satisfy 37 CFR 3.73(b)(1) because it is not accompanied by documentary evidence of a chain of title (and a request to record it) or by a statement specifying the reel and frame number where such documentation may be found in the records of the USPTO. Therefore, requirement (3) has not been satisfied. Based on the totality of the evidence of record, it would not be appropriate to conclude that the requirements of 37 CFR 1.497(d) have been satisfied.

Inspection of the declaration documents filed on 21 July 2006 reveals that they appear to have been assembled by aggregating individual sheets signed by each of the inventors into two

composite documents (each of which names a different inventive entity). Since counsel has not provided copies of the complete declaration documents signed by each inventor, it is not clear that each inventor had the benefit of signing a complete copy of the declaration document, naming the proper inventive entity. Therefore, it would not be appropriate to grant the requested relief at this time. Counsel is required to furnish a complete declaration, as signed by the inventors, nominating the complete and correct inventive entity. It is noted that one of the declaration documents filed on 21 July 2006 lists deleted inventors Keith and Exner and does not list added inventor Kelly. The other declaration filed on 21 July 2006 does list an inventive entity including the inventors nominated on the published international application, except for Keith and Exner, and also includes Kelly. However, said document is defective for the other reasons noted herein.

### CONCLUSION

The request under 37 CFR 1.497(d) is **DISMISSED**, without prejudice.

If reconsideration on the merits of this matter is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available under 37 CFR 1.136(a). Failure to timely reply will result in **ABANDONMENT** of this application. Any reconsideration request should include a cover letter entitled "Renewed Submission Under 37 CFR 1.497(d)". No additional processing fee is required.

Please direct any further correspondence with respect to this matter to the Assistant Commissioner for Patents, Mail Stop PCT, P.O. Box 1450, Alexandria, VA 22313-1450, and address the contents of the letter to the attention of the PCT Legal Office.



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